



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/003,613

11/02/2001

Lawrence P. Shields

74622-020

6203

21890

7590

01/28/2008

PROSKAUER ROSE LLP  
PATENT DEPARTMENT  
1585 BROADWAY  
NEW YORK, NY 10036-8299

EXAMINER

CHANDLER, SARA M

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

01/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/003,613	Applicant(s) SHIELDS ET AL.	
	Examiner SARA CHANDLER	Art Unit 3693	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01/04/08.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6-8,11-21 and 35-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-8,11-21 and 35-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

This Office Action is responsive to Applicant's arguments and request for continued examination of application 10/003,813 (11/02/01) filed on 10/31/07 and the supplemental amendment filed 01/04/08.

### *Claim Interpretation*

1. In determining patentability of an invention over the prior art, all claim limitations have been considered and interpreted as broadly as their terms reasonably allow. See MPEP § 2111.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Pruter*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See MPEP § 2111.

2. All claim limitations have been considered. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art. See MPEP 2106 II C. The following language is interpreted as not further limiting the scope of the claimed invention. See MPEP 2106 II C.

Language in a method claim that states only the intended use or intended result (e.g., "for \_\_\_\_\_"), but the expression does not result in a manipulative difference in the steps of the claim. Language in a system claim that states only the intended use or intended result (e.g., "for \_\_\_\_\_"), but does not result in a

Art Unit: 3693

structural difference between the claimed invention and the prior art. In other words, if the prior art structure is capable of performing the intended use, then it meets the claim.

Claim limitations that contain statement(s) such as "*if, may, might, can could*", as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.

Claim limitations that contain statement(s) such as "*wherein, whereby*", that fail to further define the steps or acts to be performed in method claims or the discrete physical structure required of system claims.

USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures or compositions of matter. See MPEP § 2106 II C.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

See MPEP § 2106 II C.

3. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct

inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-4, 6-8 and 11-21 and 35-44** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claims 1 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, essential steps and/or omitting essential structural cooperative relationships of elements such omission amounting to a gap between the elements, steps and/or the necessary structural connections. See MPEP § 2172.01. The omitted elements, steps and/or structural cooperative relationships are:

(a). Independent claims 1 and 21 recite the limitations:

communicate with a plurality of remote administration system modules, each of the plurality of remote administration system modules comprising non-volatile data storage that stores a plurality of master brokerage accounts, each of the plurality of master brokerage accounts comprising individual participant information in at least one of the plurality of different types of employee stock plans;

receive, from each of the plurality of remote administration system modules, a plurality of limited brokerage accounts, each of the limited brokerage accounts comprising a subset of the individual participant information from a corresponding master brokerage account;

The processor cannot communicate (receive (information concerning) a plurality of limited brokerage accounts from the plurality of remote administration system

Art Unit: 3693

modules unless it is communicably linked to the modules, i.e. the above two steps require separate limitation which include the aforementioned modules coupled to the processor)

The claims recite, "receive.....a plurality of limited brokerage accounts...."

Should this be -- receive.....information concerning a plurality of limited brokerage accounts --?

(b). Independent claims 1 and 21 recite the limitations:

store the plurality of limited brokerage accounts in the volatile data storage [of the finance system];

Is this same volatile data storage as the one coupled to the processor?

present an interface system module through which a participant accesses participant information in a limited brokerage account and through which the participant interacts with a trading system to conduct individual participant transactions on a public exchange;

A module is a part of a large program which carried out a specified function. You cannot present a module. You may present an interface which is what is necessary for a user to interact with the system.

(c). Independent claims 1 and 21 recite the limitations:

update the participant information of the limited brokerage account in the volatile data storage according to the individual participant transactions conducted by the participant; and

transmit the participant information updated in the limited brokerage account to a corresponding master brokerage account stored in the non-volatile data storage of a corresponding one of the plurality of remote administration system modules.

The non-volatile data storage (e.g. a hard disk type storage) referenced here must be included in the system claim as structural component.

Art Unit: 3693

(d) The claim is directed to a system (or apparatus) and recites a processor as the only element of the system. The processor is coupled to memory that comprises volatile data storage.

What are the structural elements of the system?

Currently only the processor coupled to memory.

Does the memory have any function in the claim? If so, what?

A system claim must recite limitations which define its structure.  
See discussion supra regarding claim interpretation.

The claim only recites a single element that is a processor coupled to memory (any PC has a processor (ex Intel Pentium processor) and a volatile memory (Dynamic random access memory (DRAM)).).

The claim fails to recite the limitation in a structural form.

(e) A proper form of the claim is "...the processor operable to" or "the processor is programmed to" instead of "the processor executes instructions to."

(f) From the present understanding of what applicant is trying to claim, the remote administration system modules are not structural components within the finance system. Applicant's claims need to clarify explicitly the structural components required of the claimed system and those which are not.

The claim recites certain structural components e.g. the plurality of remote administration system modules comprising which must be recited as system components.

e.g.,

Therefore, the claim takes the form of:

A data storage comprising non-volatile data storage having stored thereon a plurality of remote administration system -modules comprising ..

A processor coupled to the data storage;

The processor operable to:

Art Unit: 3693

communicate with a plurality of remote administration system-modules, each of the plurality of remote administration system -modules comprising non-volatile data storage that stores a plurality of master brokerage accounts, each of the plurality of master brokerage accounts comprising individual participant information in at least one of the plurality of different types of employee stock plans;

2. Re Claims 6,8,11-14,18-20, 35-42: The claims have been analyzed in light of the citations supra under claim interpretation. Thus, the intended meaning and scope some terms is unclear. Who is the user versus the participant and what is each parties role with respect to the inventions? If they are the same, should consistent terminology be used. Several dependent claims use language such as "enables a user to set parameters" or "enables a participant to make". Are these required limitations or are they left to the discretion of the user?

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.



**Claims 1-4, 6-8 and 11-21 and 35-44** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cristofich, US Pat. No. 6,269,346.

**Re Claims 1-4, 6-8 and 11-20.** Cristofich discloses a finance system supporting a plurality of different types of employee stock plans comprising:

a processor coupled to memory that comprises volatile data storage, the processor executes instructions to (Cristofich, abstract, col. 1, lines 13-19; col. 1, lines 45+ - col. 2, line 13; col. 2, line 30-44; col. 2, line 55-67; col. 3, lines 18-19; col. 3, lines 30+ - col. 4, line 33; col. 5, lines 37-46; col. 5, lines 58-col. 6, line 3; col. 6, lines 28-43; col. 8, lines 19-54; col. 8, lines 63+ -col. 9, lines 32; col. 10, lines 21+ - col. 11, line 7; col. 12, line 25-62):

communicate with a administration system module, the administration system module comprising non-volatile data storage that stores a plurality of master brokerage accounts, each of the plurality of master brokerage accounts comprising individual participant information in at least one of the plurality of different types of employee stock plans (Cristofich, abstract, col. 1, lines 45- 65; col. 2, lines 31-40; col. 2, lines 55-67; col. 3, lines 30 – col. 4, line 10; col. 5, line 37- col. 6, line 42; col. 8, line 47-54; col. 11, lines 49+ -- col. 12, line 13);

receive, from the administration system module, a plurality of limited brokerage accounts, each of the limited brokerage accounts comprising a subset of the individual participant information from a corresponding master brokerage account (Cristofich, abstract, col. 1, lines 45- 65; col. 2, lines 31-40; col. 2, lines 55-67; col. 3, lines 30 – col. 4, line 10; col. 5, line 37- col. 6, line 42; col. 8, line 47-54; col. 11, lines 49+ -- col. 12,

Art Unit: 3693

line 13);

store the plurality of limited brokerage accounts in the volatile data storage of the finance system (Cristofich, abstract, col. 1, lines 45- 65; col. 2, lines 31-40; col. 2, lines 55-67; col. 3, lines 30 – col. 4, line 10; col. 5, line 37- col. 6, line 42; col. 8, line 47-54; col. 11, lines 49+ -- col. 12, line 13);

present an interface system module through which a participant accesses participant information in a limited brokerage account and through which the participant interacts with a trading system to conduct individual participant transactions on a public exchange (Cristofich, abstract, col. 1, lines 45-65; col. 2, lines 45-48; col. 3, lines 1-7; col. 3, lines 65+- col. 4, line10; col. 4, lines 22-col. 4, line 33; col. 5, lines 14-17; col. 7, lines 60+ - col. 8, lines 18; col. 10, lines 1+ - col. 14, line 5 The interface is inherent, in a computer system such as the one disclosed the interface is the point of interaction or communication between the computer and another entity (e.g., human operator). Thus, there must be an interface.);

update the participant information of the limited brokerage account in the volatile data storage according to the individual participant transactions conducted by the participant (Cristofich, abstract, col. 2, lines 41-44; col. 3, lines 30-65; col. 8, lines 19-37; col. 9, lines 59-67; col. 11, lines 8- col. 12, lines 13; col. 12, lines 63+ - col. 14, line 5); and transmit the participant information updated in the limited brokerage account to a corresponding master brokerage account stored in the non-volatile data storage of a corresponding the administration system module (Cristofich, abstract, col. 1, lines 45-

Art Unit: 3693

65; col. 2, lines 31-40; col. 2, lines 55-67; col. 3, lines 30 – col. 4, line 10; col. 5, line 37-  
col. 6, line 42; col. 8, line 47-54; col. 11, lines 49+ -- col. 12, line 13).

Christofich fails to explicitly disclose:

wherein the administration system module is a remote administration module;

and wherein there are a plurality of remote administration system modules.

Without demonstrated any distinguishing functionality or purpose accomplished by making the administration system separate from the system (i.e., a remote administration system module) as opposed to being a part of the system. The administration system as separate from the finance system is interpreted as being merely a rearrangement of parts. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

Without distinguishing why a plurality of remote administration system modules would be different than a single remote administration system module, this aspect of the invention is interpreted as merely a duplication of parts. See *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Christofich to provide wherein the administration system module is a remote administration module; and wherein there are a plurality of remote administration system modules.

One would have been motivated by profits and operational efficiency to provide a system compatible with a plurality of remote administration system modules and one

Art Unit: 3693

would have been motivated to protect the security and reliability of system data to maintain non-volatile data in a remote administration system separate from the finance system.

**Re Claims 21 and 35-44:** Cristofich a method for supporting a plurality of different types of employee stock plans in a finance system(Cristofich, abstract, col. 1, lines 13-19; col. 1, lines 45+ - col. 2, line 13; col. 2, line 30-44; col. 2, line 55-67; col. 3, lines 18-19; col. 3, lines 30+ - col. 4, line 33; col. 5, lines 37-46; col. 5, lines 58-col. 6, line 3; col. 6, lines 28-43; col. 8, lines 19-54; col. 8, lines 63+ -col. 9, lines 32; col. 10, lines 21+ - col. 11, line 7; col. 12, line 25-62), comprising:

receiving, from the administration system module, a plurality of limited brokerage accounts, each of the limited brokerage accounts comprising a subset of the individual participant information from a corresponding master brokerage account stored in non-volatile storage of the administration system module (Cristofich, abstract, col. 1, lines 45- 65; col. 2, lines 31-40; col. 2, lines 55-67; col. 3, lines 30 – col. 4, line 10; col. 5, line 37- col. 6, line 42; col. 8, line 47-54; col. 11, lines 49+ -- col. 12, line 13);

storing the plurality of limited brokerage accounts in the volatile data storage of the finance system (Cristofich, abstract, col. 1, lines 45- 65; col. 2, lines 31-40; col. 2, lines 55-67; col. 3, lines 30 – col. 4, line 10; col. 5, line 37- col. 6, line 42; col. 8, line 47-54; col. 11, lines 49+ -- col. 12, line 13);

presenting an interface system module through which a participant accesses participant information in a limited brokerage account and through which the participant interacts with a trading system to conduct individual participant transactions on a public

Art Unit: 3693

exchange (Cristofich, abstract, col. 1, lines 45-65; col. 2, lines 45-48; col. 3, lines 1-7; col. 3, lines 65+- col. 4, line 10; col. 4, lines 22-col. 4, line 33; col. 5, lines 14-17; col. 7, lines 60+ - col. 8, lines 18; col. 10, lines 1+ - col. 14, line 5 The interface is inherent, in a computer system such as the one disclosed the interface is the point of interaction or communication between the computer and another entity (e.g., human operator). Thus, there must be an interface.);

updating the participant information of the limited brokerage account in the volatile data storage according to the individual participant transactions conducted by the participant (Cristofich, abstract, col. 2, lines 41-44; col. 3, lines 30-65; col. 8, lines 19-37; col. 9, lines 59-67; col. 11, lines 8- col. 12, lines 13; col. 12, lines 63+ - col. 14, line 5); and transmitting the participant information updated in the limited brokerage account to a corresponding master brokerage account stored in the non-volatile data storage of the administration system module (Cristofich, abstract, col. 1, lines 45- 65; col. 2, lines 31-40; col. 2, lines 55-67; col. 3, lines 30 – col. 4, line 10; col. 5, line 37- col. 6, line 42; col. 8, line 47-54; col. 11, lines 49+ -- col. 12, line 13).

Christofich fails to explicitly disclose:

wherein the administration system module is a remote administration module;  
and wherein there are a plurality of remote administration system modules.

Without demonstrated any distinguishing functionality or purpose accomplished by making the administration system separate from the system (i.e., a remote administration system module) as opposed to being a part of the system. The administration system as separate from the finance system is interpreted as being

Art Unit: 3693

merely a rearrangement of parts. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

Without distinguishing why a plurality of remote administration system modules would be different than a single remote administration system module, this aspect of the invention is interpreted as merely a duplication of parts. See *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Christofich to provide wherein the administration system module is a remote administration module; and wherein there are a plurality of remote administration system modules.

One would have been motivated by profits and operational efficiency to provide a system compatible with a plurality of remote administration system modules and one would have been motivated to protect the security and reliability of system data to maintain non-volatile data in a remote administration system separate from the finance system.

**Claims 1-4, 6-8 and 11-21 and 35-44** are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoen, US Pat. No. 6,235,176.

**Re Claims 1-4, 6-8 and 11-20:** Schoen discloses a finance system supporting a plurality of different types of plans comprising:

a processor coupled to memory that comprises volatile data storage, the processor executes instructions to (Schoen, Fig. 1):

Art Unit: 3693

communicate with a plurality of remote administration system modules, each of the plurality of remote administration system modules comprising non-volatile data storage that stores a plurality of master brokerage accounts, each of the plurality of master brokerage accounts comprising individual participant information in at least one of the plurality of different types of stock plans (Schoen, col. 4, lines 37-45; col. 4, lines 64+-col. 5, line 8; col. 14, lines 1-20);

receive, from each of the plurality of remote administration system modules, a plurality of limited brokerage accounts, each of the limited brokerage accounts comprising a subset of the individual participant information from a corresponding master brokerage account (Schoen, Fig. 1, col. 5, lines 37-42; col. 6, lines 8-16; col. 7, lines 20-29; col. 8, lines 33-39; col. 8, lines 53+ - line 20; col. 14, lines 1-20; col. 14, lines 25-35; col. 15, lines 4-18; col. 29, lines 27-33);

store the plurality of limited brokerage accounts in the volatile data storage of the finance system (Schoen, Fig. 1, col. 5, lines 37-42; col. 6, lines 8-16; col. 7, lines 20-29; col. 8, lines 33-39; col. 8, lines 53+ - line 20; col. 14, lines 1-20; col. 14, lines 25-35; col. 15, lines 4-18; col. 29, lines 27-33);

present an interface system module through which a participant accesses participant information in a limited brokerage account and through which the participant interacts with a trading system to conduct individual participant transactions on a public exchange (Schoen, col. 18, lines 36-41; col. 18, lines 58-63; col. 21, lines 40-55; col. 22, lines 38-44; col. 23, lines 23-30; col. 23, lines 66+ - col. 24, lines 5; col. 26, lines 32-33; col. 26, line 45; col. 27, lines 48-65);

Art Unit: 3693

update the participant information of the limited brokerage account in the volatile data storage according to the individual participant transactions conducted by the participant (Schoen, col. 18, lines 36-41; col. 18, lines 58-63; col. 21, lines 40-55; col. 22, lines 38-44; col. 23, lines 23-30; col. 23, lines 66+ - col. 24, lines 5; col. 26, lines 32-33; col. 26, line 45; col. 27, lines 48-65); and transmit the participant information updated in the limited brokerage account to a corresponding master brokerage account stored in the non-volatile data storage of a corresponding one of the plurality of remote administration system modules (Schoen, col. 5, lines 43-47; col. 10, lines 63+ - col. 11, line 11).

Schoen fails to explicitly disclose wherein the plans are employee stock plans.

Analogous art: It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, a single centralized system resolving the problem of providing administration services on behalf of a plurality of third party organizations with different system formats and plan requirements.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Schoen to provide wherein the plans are employee stock plans.



As suggested by Schoen, one would have been motivated to provide a single centralized system for providing administration services on behalf of a plurality of third party organizations with different system formats and plan requirements.

**Re Claims 21 and 35-44:** Schoen discloses a method for supporting a plurality of different types of plans in a finance system, comprising:

receiving, from a plurality of remote administration system modules, a plurality of limited brokerage accounts, each of the limited brokerage accounts comprising a subset of individual participant information of a corresponding master brokerage account stored in non-volatile data storage of the a corresponding one of the plurality of remote administration system modules (Schoen, Fig. 1, col. 5, lines 37-42; col. 6, lines 8-16; col. 7, lines 20-29; col. 8, lines 33-39; col. 8, lines 53+ - line 20; col. 14, lines 1-20; col. 14, lines 25-35; col. 15, lines 4-18; col. 29, lines 27-33);

storing the plurality of limited brokerage accounts in volatile data storage of the finance system (Schoen, Fig. 1, col. 5, lines 37-42; col. 6, lines 8-16; col. 7, lines 20-29; col. 8, lines 33-39; col. 8, lines 53+ - line 20; col. 14, lines 1-20; col. 14, lines 25-35; col. 15, lines 4-18; col. 29, lines 27-33);

presenting an interface system module through which a participant accesses participant information in a limited brokerage account and through which the participant interacts with a trading system to conduct individual participant transactions on a public exchange (Schoen, col. 18, lines 36-41; col. 18, lines 58-63; col. 21, lines 40-55; col. 22, lines 38-44; col. 23, lines 23-30; col. 23, lines 66+ - col. 24, lines 5; col. 26, lines 32-33; col. 26, line 45; col. 27, lines 48-65);

Art Unit: 3693

updating the participant information of the limited brokerage account in the volatile data storage according to the individual participant transactions conducted by the participant (Schoen, col. 18, lines 36-41; col. 18, lines 58-63; col. 21, lines 40-55; col. 22, lines 38-44; col. 23, lines 23-30; col. 23, lines 66+ - col. 24, lines 5; col. 26, lines 32-33; col. 26, line 45; col. 27, lines 48-65); and

transmitting the participant information updated in the limited brokerage account to a corresponding master brokerage account stored in the non-volatile data storage of a corresponding one of the plurality of the remote administration system modules (Schoen, col. 5, lines 43-47; col. 10, lines 63+ - col. 11, line 11).

Schoen fails to explicitly disclose wherein the plans are employee stock plans.

Analogous art: It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, a single centralized system resolving the problem of providing administration services on behalf of a plurality of third party organizations with different system formats and plan requirements.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Schoen to provide wherein the plans are employee stock plans.

As suggested by Schoen, one would have been motivated to provide a single centralized system for providing administration services on behalf of a plurality of third party organizations with different system formats and plan requirements.

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive.

As noted supra, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Cristofich.

Regarding, "wherein there are a plurality of remote administration system modules."

This aspect of the invention is interpreted as merely a duplication of parts. See *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Regarding, "wherein the administration system module is a remote administration module;"

The administration system as separate from the finance system is interpreted as being merely a rearrangement of parts. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

### ***Conclusion***

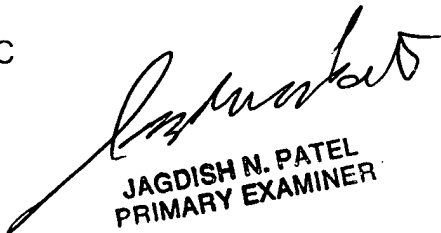
Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARA CHANDLER whose telephone number is (571)272-1186. The examiner can normally be reached on 8-4:30.

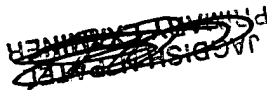
Art Unit: 3693

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC

  
JAGDISH N. PATEL  
PRIMARY EXAMINER

  
JAGDISH N. PATEL  
PRIMARY EXAMINER